

**10/506335**  
DT09 Rec'd PCT/PTO 02 SEP 2004

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q68931

**Eiko KATO, et al.**

Appln. No.: Unknown

Confirmation No.: Not yet assigned

Group Art Unit: Not yet assigned

Filed: **September 2, 2004**

Examiner: Not yet assigned

For: **WHITENING COSMETIC COMPOSITION**

**INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 C.F.R. §§ 1.97 and 1.98**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. § 1.56, Applicant hereby notifies the U.S. Patent and Trademark Office of the documents which are listed on the attached PTO/SB/08 A & B (modified) form and/or listed herein and which the Examiner may deem material to patentability of the claims of the above-identified application.

One copy of each of the listed documents submitted herewith, as is a Communication from a foreign patent office.

The present Information Disclosure Statement is being filed: (1) No later than three months from the application's filing date; (2) Before the mailing date of the first Office Action on the merits (whichever is later); or (3) Before the mailing date of the first Office Action after filing a request for continued examination (RCE) under §1.114, and therefore, no Statement under 37 C.F.R. § 1.97(e) or fee under 37 C.F.R. § 1.17(p) is required.

INFORMATION DISCLOSURE STATEMENT  
U.S. Appln. No.: Based on PCT/JP03/02646

In compliance with the concise explanation requirement under 37 C.F.R. § 1.98(a)(3) for foreign language documents, Applicant encloses herewith a copy of a Communication from a foreign patent office in a counterpart application citing such a document, together with an English-language version (if not already included) of at least that portion of the Communication indicating the degree of relevance found by the foreign patent office. Also, the foreign language document, WO 98/51679, includes an English-language Abstract.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,



Bruce E. Kramer  
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SUGHRUE MION, PLLC  
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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

BEK/lck

Date: September 2, 2004

Substitute for Form 1449 A &amp; B/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet

1

of

1

Classification if Known

Application Number

10/506335

Confirmation Number

Not yet assigned

Filing Date

September 2, 2004

First Named Inventor

Eiko KATO, et al.

Art Unit

Not yet assigned

Examiner Name

Not yet assigned

Attorney Docket Number

Q68931

**U.S. PATENT DOCUMENTS**

| Examiner Initials* | Cite No. <sup>1</sup> | Document Number |                                      | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant of Cited Document |
|--------------------|-----------------------|-----------------|--------------------------------------|--------------------------------|---|
|                    |                       | Number          | Kind Code <sup>3</sup><br>(if known) |                                |   |
| /S.R.G./           |                       | US 2,988,553    |                                      | 06/13/1961                     | Willi KÜSSNER, et al.                           |
| /S.R.G./           |                       | US 5,932,612    | A                                    | 08/03/1999                     | Benjamin D. GORDON, et al.                      |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |

**FOREIGN PATENT DOCUMENTS**

| Examiner Initials* | Cite No. <sup>1</sup> | Foreign Patent Document   |                     |                                      | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Translation <sup>6</sup> |
|--------------------|-----------------------|---------------------------|---------------------|--------------------------------------|--------------------------------|---|--------------------------|
|                    |                       | Country Code <sup>3</sup> | Number <sup>4</sup> | Kind Code <sup>3</sup><br>(if known) |                                |   |                          |
| /S.R.G./           |                       | WO                        | 03/037290           | A1                                   | 05/08/2003                     | SHOWA DENKO K.K.                                |                          |
|                    |                       | WO                        | 98/51679            | A1                                   | 11/19/1998                     | LVMH RECHERCHE                                  |                          |
|                    |                       |                           |                     |                                      |                                |   |                          |
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**NON PATENT LITERATURE DOCUMENTS**

| Examiner Initials* | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city, and/or country where published. | Translation <sup>6</sup> |
|--------------------|-----------------------|--|--------------------------|
| /S.R.G./           |                       | MASAMITSU ICHIHASHI, et al./The Inhibitory Effect of DL-a-Tocopheryl Ferulate in Lecithin on Melanogenesis/Anticancer Research 19: 3769-3774 (1999)  |                          |
| /S.R.G./           |                       | JIRO TAKATA, et al./Prodrugs of Vitamin E. 1. Preparation and Enzymatic Hydrolysis of Aminoalkancarboxylic Acid Esters of d-a-Tocopherol/ Journal of Pharmaceutical Sciences, Vol. 84, No. 1, January 1995, pages 96-100   |                          |
| /S.R.G./           |                       | KARLA WERNINGHAUS, MD et al./ Evaluation of the Photoprotective Effect of Oral Vitamin E Supplementation/ Arch. Dermatol.; 130:1257-1261, October 1994   |                          |
| /S.R.G./           |                       | Abstract of YUZURU AOKI, et al./ Skin Cosmetics Containing Vitamin E Derivatives and Citrus Junos Extracts (Database accession no. 134:256613 CA for JP 2001-081022A dated March 27, 2001)   |                          |
| /S.R.G./           |                       | Patent Abstracts of Japan, Vol. 014, No. 397 (C-0752), August 28, 1990 for JP-A-2-149577 (Eisai Co., Ltd.)   |                          |

Examiner Signature

**BEST AVAILABLE COPY**  
/Shelley R. Graham/

Date Considered

12/12/2007

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kind Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to indicate here if English language Translation is attached.



*Ifw*

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q68931

Eiko KATO, et al.

Appln. No.: 10/506,335

Group Art Unit: 1617

Confirmation No.: 8830

Examiner: Not yet assigned

Filed: September 01, 2004

For: WHITENING COSMETIC COMPOSITION

**INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 C.F.R. §§ 1.97 and 1.98**

**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. § 1.56, Applicant hereby notifies the U.S. Patent and Trademark Office of the documents which are listed on the attached PTO/SB/08 A & B (modified) form and/or listed herein and which the Examiner may deem material to patentability of the claims of the above-identified application.

One copy of each of the listed documents is submitted herewith, except for the following: U.S. patents and/or U.S. patent publications; and co-pending non-provisional U.S. applications filed after June 30, 2003. Also submitted herewith is an Office Action in a corresponding Japanese patent application received from the Japanese Patent Office on February 28, 2006.

The present Information Disclosure Statement is being filed: (1) No later than three months from the application's filing date; (2) Before the mailing date of the first Office Action

on the merits (whichever is later); or (3) Before the mailing date of the first Office Action after filing a request for continued examination (RCE) under §1.114, and therefore, no Statement under 37 C.F.R. § 1.97(e) or fee under 37 C.F.R. § 1.17(p) is required. Nevertheless, since a Statement can be made, a Statement is submitted herewith.

The present Information Disclosure Statement is being filed thirty days or fewer from the communication from a foreign patent office and a Statement Under 37 C.F.R. §1.704(d) is attached.

In compliance with the concise explanation requirement under 37 C.F.R. § 1.98(a)(3) for foreign language documents, Applicant submits the following explanations: The submission of English language abstracts for JP-A-6-72845, JP-A-62-106005, JP-A-5-186324, JP-A-10-120524, JP-A-2-149576, JP-A-2-149577, JP-A-1-121284, and JP-A-1-121285 constitutes a concise statement of relevance of JP-A-6-72845, JP-A-62-106005, JP-A-5-186324, JP-A-10-120524, JP-A-2-149576, JP-A-2-149577, JP-A-1-121284, and JP-A-1-121285.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

INFORMATION DISCLOSURE STATEMENT  
U.S. Application No.: 10/506,335

Attorney Docket No. Q68931

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: March 29, 2006

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Eiko KATO, et al.

Appln. No.: 10/506,335

Confirmation No.: 8830

Filed: September 01, 2004

For: WHITENING COSMETIC COMPOSITION

Docket No: Q68931

Group Art Unit: 1617

Examiner: Not yet assigned



**STATEMENT UNDER 37 C.F.R. § 1.704(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The undersigned hereby states, upon information and belief:

That each item of information contained in the Information Disclosure Statement filed concurrently herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and that the communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of said Information Disclosure Statement.

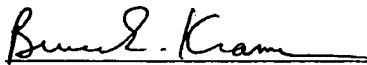
Respectfully submitted,

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
Bruce E. Kramer  
Registration No. 33,725

Date: March 29, 2006

|   |                        |                      |                    |
|---|------------------------|----------------------|--------------------|
| Substitute for Form 1449 A & B/PTO  |                        | Complete if Known    |                    |
| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br>(use as many sheets as necessary) |                        | Application Number   | 10/506,335         |
|   |                        | Confirmation Number  | 8830               |
|   |                        | Filing Date          | September 01, 2004 |
|   |                        | First Named Inventor | Eiko KATO          |
|   |                        | Art Unit             | 1617               |
|   |                        | Examiner Name        | Not yet assigned   |
| Sheet 1 of 1  | Attorney Docket Number | Q68931               |                    |

## U.S. PATENT DOCUMENTS

| Examiner Initials* | Cite No. <sup>1</sup> | Document Number |                                      | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant of Cited Document |
|--------------------|-----------------------|-----------------|--------------------------------------|--------------------------------|---|
|                    |                       | Number          | Kind Code <sup>3</sup><br>(if known) |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |
|                    |                       | US              |                                      |                                |   |

## FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. <sup>1</sup> | Foreign Patent Document   |                     |                                      | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Translation <sup>6</sup> |
|--------------------|-----------------------|---------------------------|---------------------|--------------------------------------|--------------------------------|---|--------------------------|
|                    |                       | Country Code <sup>2</sup> | Number <sup>4</sup> | Kind Code <sup>3</sup><br>(if known) |                                |   |                          |
| /S.R.G./           |                       | JP                        | 6-72845             | A                                    | 03-15-1994                     | EISAI CO LTD                                    | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 62-106005           | A                                    | 05-16-1987                     | SANSHO SEIYAKU KK                               | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 5-186324            | A                                    | 07-27-1993                     | SUNSTAR INC                                     | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 10-120542           | A                                    | 05-12-1998                     | BEIERSDORF AG<br>ICHIMARU PHARCOS CO LTD        | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 2-149576            | A                                    | 06-08-1990                     | EISAI CO LTD                                    | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 2-149577            | A                                    | 06-08-1990                     | EISAI CO LTD                                    | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 1-121284            | A                                    | 05-12-1989                     | EISAI CO LTD                                    | ABSTRACT                 |
| /S.R.G./           |                       | JP                        | 1-121285            | A                                    | 05-12-1989                     | EISAI CO LTD                                    | ABSTRACT                 |
|                    |                       |                           |                     |                                      |                                |   |                          |
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|                    |                       |                           |                     |                                      |                                |   |                          |

## NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city, and/or country where published. | Translation <sup>6</sup> |
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|--------------------|---------------------|-----------------|------------|
| Examiner Signature | /Shelley R. Graham/ | Date Considered | 12/12/2007 |
|--------------------|---------------------|-----------------|------------|

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kind Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov), MPEP 901.04 or in the comment box of this document. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to indicate here if English language Translation is attached.